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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
09/534,647	03/23/2000	Curtis K Ohrt	INS0010US	1572		
33031	7590	12/18/2008	EXAMINER			
CAMPBELL STEPHENSON LLP 11401 CENTURY OAKS TERRACE BLDG. H, SUITE 250 AUSTIN, TX 78758				NGUYEN, LE V		
ART UNIT		PAPER NUMBER				
2174						
MAIL DATE		DELIVERY MODE				
12/18/2008		PAPER				

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CURTIS K. OHRT, MICHAEL R. MARTIN, XIAOFENG MA,
ROBERT J. DUGAN, STEVEN HORIO, SRIDHAR GUNAPU, and
DEEPAKAR NARAYANAN

Appeal 2008-1824
Application 09/534,647
Technology Center 2100

Decided: December 18, 2008

Before LANCE LEONARD BARRY, JAY P. LUCAS, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-32. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

The Invention

The disclosed invention relates generally to interfacing with application forms over an Internet (Spec. 1). Specifically, a user interface maintains virtual application information, relative dependencies, and information context. The state of an application is maintained during use of browser Back and Forward button functions without loss of data (Spec. 15).

Independent claim 1 is illustrative:

1. A method of providing an intelligent user interface to an on-line application comprising the steps of:

furnishing a plurality of icons on a web page displayed to a user of a web browser, wherein each said icon is a hyperlink to a dynamically generated on-line application form set and wherein said web browser comprises Back and Forward Navigation functionalities;

displaying said dynamically generated on-line application form set in response to the activation of said hyperlink, wherein said dynamically generated on-line application form set comprises a state determined by at least one user input; and

maintaining said state upon the activation of another said icon wherein said maintaining allows the user of said Back and Forward navigation functionalities without loss of said state.

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The References

The Examiner relies upon the following references as evidence in support of the obviousness rejection:

Gershman	US 6,199,099 B1	Mar. 6, 2001
Torres	US 6,424,360 B1	Jul. 23, 2002

The Rejection

The Examiner rejects claims 1-32 under 35 U.S.C. § 103(a) as being unpatentable over Gershman and Torres.

ISSUE

The Examiner finds that “Gershman does not explicitly describe maintaining the state upon the activation of another icon wherein maintaining it allows the user of the Back and Forward navigation functionalities without loss of the state” (Ans. 4) but that “the use of the Back/Forward navigation functionalities without loss of . . . state is inherent so that users may revisit a previously viewed page in its original state” (Ans. 4-5).

Appellants assert that “the Examiner has provided no such evidence or rationale tending to show inherency” (App. Br. 6).

Did Appellants demonstrate that the Examiner erred in finding that the Gershman system inherently maintains state of a dynamically generated on-line application form set?

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FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

1. Gershman discloses an “agent . . . communicating information 2300 to a user indicating that the user’s life insurance needs have changed” (col. 36, ll. 65-67).
2. Gershman discloses a “chart 2370 of the user’s life insurance needs is also highlighted at the center of the display to assist the user in determining appropriate action” (col. 37, ll. 3-6).
3. Gershman discloses a “button 2380 is provided to facilitate changing the policy and a set of buttons 2390 are provided to assist a user in selecting various views of the user’s insurance requirements” (col. 37, ll. 6-9).

PRINCIPLES OF LAW

35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR*, 127 S. Ct. at 1742. In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

The Federal Circuit recently recognized that “[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. at 1739). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1741).

Inherency

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. § 102 or 103. “The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.” *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995) (affirmed a 35 U.S.C. § 103 rejection based in part on inherent disclosure in one of the references). See also *In re Grasselli*, 713 F.2d 731, 739 (Fed. Cir. 1983).

The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”’ *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted).

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) (citations omitted).

ANALYSIS

Independent claims 1, 9, 17, and 25 recite “displaying said dynamically generated on-line application form set . . . [comprising] a state” and “maintaining said state . . . said maintaining allows the use of said Back and Forward navigation functionalities without loss of said state” (App. Br. 9-13).

The Examiner states that Gershman does not disclose “maintaining the state [of a dynamically generated on-line application form set] . . . wherein maintaining it allows the use of the Back and Forward navigation functionalities without loss of the state [of the dynamically generated on-line application form set]” (Ans. 4). The Examiner further finds that “the use of the Back/Forward navigation functionalities without loss of . . . state is inherent” in the Gershman system (Ans. 4-5). However, the Examiner does not provide a basis in fact or technical reasoning to support the determination of inherency. The Examiner states that the Gershman system inherently maintains state of the application “so that users may revisit a previously viewed page in its original state” (Ans. 5) but does not demonstrate that this proposed improvement or advantage in a potential feature of Gershman necessarily flows from the teachings of Gershman. Even assuming that the disputed feature is “probably” or “possibly” present in the Gershman system, we disagree with the Examiner that the disputed feature is inherent in the Gershman system because a feature is inherent only if the feature is necessarily present. “Inherency . . . may not be established

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by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”” *In re Robertson*, 169 F.3d at 745.

Accordingly, we conclude that Appellants have met their burden of showing that the Examiner erred in rejecting independent claims 1, 9, 17, and 25. Therefore, we reverse the Examiner’s rejection of claims 1, 9, 17, and 25, and of claims 2-8, 10-16, 18-14, and 26-32, which depend therefrom.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have demonstrated that the Examiner erred in finding that the Gershman system inherently maintains state of a dynamically generated on-line application form set.

DECISION

We reverse the Examiner’s decision rejecting claims 1-32 under 35 U.S.C. § 103.

REVERSED

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msc

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